

DOCKET NO. 01-P-002 (STMI01-00013)

PATENT

Customer No. 30425

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: : CHARLES R. SPINNER, III ET AL

Serial No. : 09/871,463

Filed : May 31, 2001

For : BARRIER FILM DEPOSITION OVER METAL FOR
REDUCTION IN METAL DISHING AFTER CMP

Group No. : 2815

Examiner : M.E. Warren

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

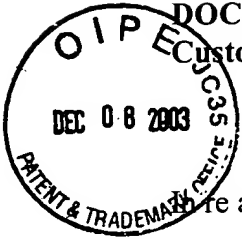
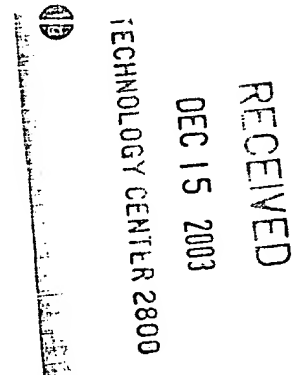
Sir:

REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

In response to the new Restriction Requirement mailed October 29, 2003, Applicant respectfully requests reconsideration of the restriction requirement.

The restriction requirement characterizes claims 8–20 (Group I) as drawn to “an intermediate device” and claims 1–7 as drawn to “a method of making a semiconductor device.” Paper No. 13, page 2. The Restriction Requirement provides no factual basis for asserting either independence or distinctness of these claims, making only the factually-unsupported statements:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP §



806.04(h)). In the instant case, the intermediate product is deemed to be useful as a circuit comprising a conformal tungsten layer and protective barrier layer formed over the substrate and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

Paper No. 13, page 2. A restriction requirement must provide the particular factual basis for asserting that restriction is necessary:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP § 816, p. 800-56 (8th ed. rev. 1 February 2003). The restriction requirement fails to provide such a factual basis (as opposed to a “mere statement of conclusion”) indicating why the claims recite patentably distinct species--that is, a factual basis for asserting that: (a) “the intermediate product is useful to make other than the final product”; and (b) “the species are patentably distinct.”

In addition, restriction is only proper where the claims are independent or distinct. MPEP § 806. In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01, p. 800-39. The restriction requirement tacitly concedes that the claims are not independent (i.e., are related), but incorrectly states the relationship among the inventions claimed. Claims 1–7 are directed to a process of making a product, which process may be employed to make either an intermediate product or a final product. Claims 8–15 are directed to the intermediate product that may be made by the process. Claims

16–20 are directed to the final product that may be made by the process. Claims 1–7 and claims 8–20 are thus related as a process for making and the product made, while claims 8–15 are related as intermediate-final product species. Accordingly, to establish distinctness of claims 1–7 from claims 8–20 (or distinctness of claims 1–7 from either claims 8–15 or claims 16–20), either or both of the following must be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process. MPEP § 806.05(f), p. 800-45 (emphasis in original). To establish distinctness of claims 8–15 from claims 16–20, a showing must be made that (A) the intermediate and final product have a mutually exclusive species relationship and, as with all species restrictions, are patentably distinct (typically found in cases in which the intermediate product loses its identity in transformation to the final product); and (B) the intermediate is useful to make other than the final product. MPEP § 806.04(b), p. 800-40. The examiner must give an example of such an alternative use. *Id.*

The original restriction requirement asserted that claims 1–7 were distinct from claims 8–20, related as process of making and product made, because “etching, instead of chemical mechanical polishing, could be used to remove portions of the protective barrier layer.” As previously noted, this assertion fails to establish distinctness of claims 1–7 from claims 8–15 since at least independent claim 8 is directed to an intermediate product in which no removal of the protective barrier layer (whether by etching or chemical mechanical polishing) has necessarily been performed. The

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restriction requirement accordingly failed to establish that the product *as claimed* in claims 1-7 could be made by another and materially different process than the process *as claimed* in claims 8-15.

With respect to distinctness of claims 8-15 from claims 16-20, the restriction requirement fails to satisfy any of the requirements.

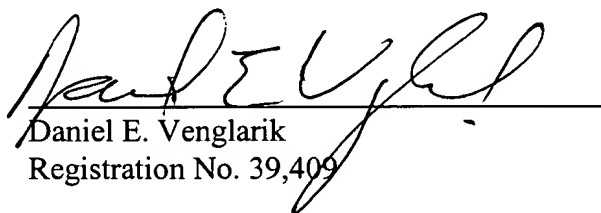
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

12-1-03


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Sir:

RESPONSE TO NOTICE OF NON-COMPLIANCE

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In response to the Notice of Non-Compliance With 37 C.F.R. 1.192(c) mailed October 29, 2003, Applicant respectfully requests withdrawal of the Notice. A Substitute Brief on Appeal is being concurrently filed to address the jurisdictional issue raised in the Notice and to correct various grammatical and typographical errors within Appellant's Brief on Appeal as filed. A request for reconsideration of the new restriction requirement attached to the Notice is also being filed concurrently herewith.

The Notice asserts that the brief does not contain a correct copy of the appealed claims as an appendix thereto, and states as "Other" reason(s) for non-compliance:

The brief contains non-appealable issues. The applicant's arguments pertaining to the Restriction are non-appealable issues that should not be present in the brief. However, the arguments against the restriction are petitionable issues that should be filed in a separate paper. The appealed claims in the appendix section are not correct because withdrawn or non-elected claims 1-7 are included in that section. Withdrawn claims 1-7 are non-appealable claims and should be removed from the appendix to make the brief compliant. In response to the letter dated on March 19, 2003 concerning the restriction requirement, a new restriction is attached to this Notice. Based on the comments that the claim 8 reads on a structure prior to removal of portions of the barrier layer, the invention of claims 1-7 are now viewed as a method of making the final product and the claims of 8-20 are viewed as an intermediate device, each being distinct inventions. For the reasons stated in the letter, the new restriction is proper.

Paper No. 13. The relevant portion of the Notice thus states two objections to Appellant's Brief on Appeal as filed: (1) that the appeal brief contains an argument directed to a "non-appealable" issue; and (2) that the appendix includes withdrawn (non-elected) claims. Neither objection is a proper basis for asserting non-compliance with 37 C.F.R. § 1.192(c).

The requirements set forth in 37 C.F.R. § 1.192(c) are compulsory but not exclusive. The rule states that "[t]he brief shall contain the following items . . .," but does NOT state that the brief must contain only the items listed, or that no other items are permitted. Neither the rule nor the MPEP confers upon the Examiner the authority to decide what subject matter should NOT be contained within an appeal brief; instead, the Examiner is empowered only to determine whether required subject matter IS present within the brief. See MPEP § 1206, p. 1200-8 through 1200-15 (8th ed. rev. 1 February 2003). In particular, the MPEP states:

37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may

consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end). . . .

The question of whether the brief complies with the rule is a matter within the jurisdiction of the examiner. 37 CFR 1.192(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. . . .

MPEP § 1206, p. 1200-11 (emphasis added). The Examiner's authority is thus limited to review of the appeal brief for compliance with the requirements of the rule. Accordingly, the presence of subject matter not specified in 37 C.F.R. § 1.192(c), as opposed to the absence of subject matter required under 37 C.F.R. § 1.192(c), is not an appropriate basis for asserting non-compliance of the appeal brief with the rule. The presence of arguments directed to non-appealable issues does not render the brief non-compliant with the rule.

Applicant is aware of *In re Hengehold*, 440 F.2d 1395 (CCPA 1971). However, nothing in the rules or the MPEP confers upon the Examiner the power to dismiss an appeal as including arguments outside the jurisdiction of the Board of Patent Appeals and Interferences (BPAI). In addition, a Substitute Brief on Appeal is being concurrently filed to address the issue of the Board's jurisdiction.

Furthermore, the merits of the restriction requirement are probative of the overall quality of examination in the instant application. Even if the BPAI lacks jurisdiction to affirm or reverse a restriction requirement, the propriety of a restriction requirement asserted during prosecution of the

application is an appropriate factor for the BPAI to consider in evaluating the credibility of the interpretations and arguments asserted by Applicant and the Examiner.

Similar to the observations above regarding the content of an appeal brief, 37 C.F.R. § 1.192(c)(9) merely requires the appendix to an appeal brief to contain the claims being appealed. Inclusion of other pending (withdrawn and/or non-elected) claims is not precluded. Inclusion of such claims in the appendix is not a basis for asserting non-compliance.

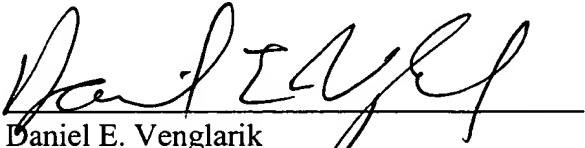
Accordingly, Applicant requests withdrawal of the Notice of Non-Compliance.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 12-1-03


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